



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/556,725	04/21/2000	Thomas Anthony Cofino	YOR9-2000-0148US1	6637

7590 08/24/2004

Louis J Percello
Intellectual Property Law Department
IBM Corporation
P O Box 218
Yorktown Heights, NY 10598

EXAMINER

FULTS, RICHARD C

ART UNIT	PAPER NUMBER
----------	--------------

3628

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/556,725

Applicant(s)

COFINO ET AL.

Examiner

Richard Fults

Art Unit

3628

WJ

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (WO 98/10361).

As to Claims 1-19 Walker discloses either explicitly or implicitly as obvious (see at least pages 1-175, but in particular pages 1-10) the **capability** of providing a user with access to an online store through a network, the store having named products with a description of its attributes and features and a price made available to the user, receiving selection requests for selected products, enabling the user to conduct a product purchase transaction for said one or more products one of the products being a selected product, in a fixed shopping mode directly via a seller's online store or alternately enabling the user to dynamic price shop by providing the user with access to bid conditions for the selected products or services or entertainment tickets, receiving a bid request from the user, in response to said received bid request implementing an auction in real time for generating second bids for the selected product, providing the user with one or more second bid(s) for the selected product originating from other store(s) participating in a reverse auction who are pre-registered (participating) and agree to provide the second bids for a related product at a

Art Unit: 3628

checkout time or after placing the bid conditions, with each of the second bids conforming to the bid conditions, enabling the user to complete a purchase transaction either from seller's online store or one of the other stores, which bid conditions are arranged in an order according to one or more of the attributes, with that order based on any of a number of product attributes including price, where one or more of the products has more than one component which can include a product or a service, where one or more of the components is provided from a different other store and the bid is a joint bid between one or more of the other stores, where the product includes a set of one or more of the other products and a service, where the user's personal information is not disclosed to the other stores, and wherein the user's choice of the products offered and the stores offering those alternative products or prices through the user making a choice between them become identified and pre-selected by the user at the time of the purchase transaction.

It would have been obvious to one skilled in the art at the time of the invention to have listed some of the bid conditions from which a buyer could select in addition to those proposed by the buyer, and not only be familiar with Walker's well known invention but also to be able to use it with multiple variations of its many conditions and practices (the patent is 175 pages long, excluding over 85 pages of drawings), which collectively include all of the applicant's claims, because it would be common sense and advantageous.

2. Response to Applicants Argument

The applicant is essentially making only two arguments, and the first is that the **product and store were identified and preselected by the user** and that Walker is alleged not to have taught that feature. The alleged specification support for this argument on page 13 does **not** state that these products and stores were identified and pre-selected by the user except in the sense that they were part of an established network, which **network** was identified and pre-selected by the user. However that is the same step and feature taught by

Art Unit: 3628

Walker. In neither case does the user become aware of the identity of all the specific product offerings or stores until after the initial search has been made to identify them. In both cases the user then becomes aware of the product offerings and stores offering them and selects both by the time of purchase. So the argued term in the claim of "identified and pre-selected by the user" is simply a play on words, with no substance to differentiate it from Walker.

The second argument is that Walker does not teach the applicant's **dynamic shopping mode**. Official notice is taken that the **capability** of such a "dynamic shopping mode" is really just the very old and common, well known practice of a buyer making an inquiry of one or more sellers (either online or offline) as to what those sellers would offer to sell an item for, and then comparing prices to see which one they wanted to buy from if that price was better than from the merchant they were originally online or in contact with. Those sellers may or may not be told they were competing with others for the best price, in effect making it an "auction".

3. Note is taken by the examiner that should the applicant find objectionable any statements made herein by the examiner regarding inherency, implicitness, obviousness, or Official Notice, Applicant can make a proper challenge to those statements only by providing adequate information or argument so that on its face it creates a reasonable doubt regarding the circumstances justifying those statements: a simple response requesting a reference without doing so, or a response that fails to logically refute the basic assumptions underlying the justification, will result in an improper and failed challenge and those unchallenged statements will remain the record of the case. Applicants must seasonably challenge those statements in the first response following an Office Action. If an applicant fails to do so, his right to challenge them is waived.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Fults whose telephone number is

Art Unit: 3628


703-305-5416. The examiner can normally be reached on weekdays from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough, can be reached on (703)-305-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


RCF

8/19/2003


JEFFREY PWU
PRIMARY EXAMINER